

REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.116 and in light of the remarks which follow, are respectfully requested.

By the above amendments, claim 3 has been canceled without prejudice or disclaimer. Claim 1 has been amended to recite the phrase "and cooling and pulverizing the resulting mixture." Support for such amendment can be found in the instant specification at least at page 47, lines 2-7. Claim 1 has also been amended for clarification purposes by deleting the phrase "or a graft copolymer having the repeating unit (a) in the main chain thereof." Thus, claim 1 now recites that "the binder resin comprises a block copolymer having a repeating unit (a) corresponding to a monofunctional monomer containing an aliphatic cyclic hydrocarbon group having from 5 to 30 carbon atoms." Entry of the above amendments is proper at least because they place the application in condition for allowance or in better form for appeal. See 37 C.F.R. §1.116.

In the Official Action, claims 1-5 and 7 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Without addressing the propriety of this rejection, it is noted that the Patent Office has acknowledged that "the specification provides support to recite that the colored mixture is obtained by melting and kneading a coloring agent and a binder resin, followed by cooling, and then pulverizing" (Official Action at page 3). As noted above, claim 1 has been amended to recite "cooling and pulverizing the resulting mixture." Accordingly, it is apparent that the §112 rejection is now moot, and withdrawal of such rejection is respectfully requested.

Claims 1-3 and 5 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,254,425 (*Suzuki et al*). Claims 1, 2, 4 and 6 stand rejected under 35 U.S.C.

§102(b) as being anticipated by U.S. Patent No. 6,302,537 (*Kato*). Claims 1, 4 and 6 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0128349 (*Qian et al*).¹ Withdrawal of the above rejections is respectfully requested for at least the following reasons.

Independent claim 1 is directed to a method of forming an image by an inkjet recording system using an oil based ink composition, comprising discharging an oil based ink composition from an inkjet recording device, wherein the oil based ink composition comprises fine particles dispersed in a non-aqueous dispersion medium, wherein the fine particles are obtained by melting and kneading a coloring agent and a binder resin and cooling and pulverizing the resulting mixture to provide a colored mixture and subjecting the colored mixture to wet dispersion, wherein each fine particle comprises the coloring agent and the binder resin, and wherein the coloring agent is coated with the binder resin, and wherein the binder resin comprises a block copolymer having a repeating unit (a) corresponding to a monofunctional monomer containing an aliphatic cyclic hydrocarbon group having from 5 to 30 carbon atoms.

Suzuki et al, *Kato* and *Qian et al* fail to disclose each feature recited in claim 1. For example, each of the above applied documents fails to disclose or suggest employing a binder resin which comprises a block copolymer having a repeating unit (a) corresponding to a monofunctional monomer containing an aliphatic cyclic hydrocarbon group having from 5 to 30 carbon atoms, as recited in claim 1. In this regard, Applicants note that the Patent Office has relied on *Suzuki et al* and *Qian et al* for disclosing the use of graft copolymers, and not a block copolymer as is presently claimed (Official Action at pages 3 and 6). Furthermore, *Kato* fails to disclose with the requisite certainty that the copolymer resulting from the

¹ It is noted that claim 6 was canceled in the Amendment previously filed on January 3, 2006. Accordingly, the rejection of such claim is moot.

disclosed monofunctional monomer (A) and resin for dispersion stabilization (P), is the same as the claimed binder resin which comprises a block copolymer having a repeating unit (a) corresponding to a monofunctional monomer containing an aliphatic cyclic hydrocarbon group having from 5 to 30 carbon atoms, which is used to obtain the claimed fine particles.

Accordingly, for at least the above reasons, it is apparent that *Suzuki et al*, *Kato* and *Qian et al* fail to anticipate the claims. As such, withdrawal of the above rejections is respectfully requested.

Claim 7 stands rejected under 35 U.S.C. §103(a) as being obvious *Suzuki et al*, *Kato* or *Qian et al*, any of which in view of U.S. Patent No. 6,465,567 (*Grobe et al*). Withdrawal of this rejection is respectfully requested for at least the following reasons.

For the reasons discussed above, *Suzuki et al*, *Kato* and *Qian et al* fail to disclose or suggest employing a binder resin which comprises a block copolymer having a repeating unit (a) corresponding to a monofunctional monomer containing an aliphatic cyclic hydrocarbon group having from 5 to 30 carbon atoms, as recited in claim 1. *Grobe et al* fails to cure the above-described deficiencies of *Suzuki et al*, *Kato* and *Qian et al*. In this regard, the Patent Office has relied on *Grobe et al* for disclosing "adjusting the surface tension for inks used in conventional ink jet printers to 0.5-10 mPas" (Official Action at page 8). However, like the other applied art, *Grobe et al* fails to disclose or suggest employing a binder resin which comprises a block copolymer having a repeating unit (a) corresponding to a monofunctional monomer containing an aliphatic cyclic hydrocarbon group having from 5 to 30 carbon atoms.

For at least the above reasons, it is apparent that no *prima facie* case of obviousness exists. Accordingly, withdrawal of the §103(a) rejection is respectfully requested.

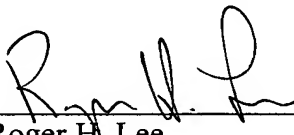
From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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